

App. Serial No. 10/567,172
Docket No.: US030276US2

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Remarks

Claims 1-8 are currently pending in the patent application. For the reasons and arguments set forth below, Applicant respectfully submits that the claimed invention is allowable over the cited references.

The non-final Office Action dated October 10, 2006 indicated that claims 1-8 stand rejected under 35 U.S.C. § 101; indicated informalities in the abstract; suggested a layout for the specification to include section headings; objected to the drawings; objected to claims 2-4, and 6-8; and indicated that claims 1 and 5 stand rejected under 35 U.S.C. § 103(a) over Roberts *et al.* (U.S. 6,064,501).

Applicant appreciates the Examiner's attention to details in the specification and claims. While any amendment is believed unnecessary for clarity, Applicant has amended the abstract to remove the word "comprises" as suggested.

Applicant respectfully declines to add section headings to the specification because the indicated suggestions in 37 C.F.R. § 1.77(b) are not statutorily required for filing a non-provisional patent application under 35 USC § 111(a), but per 37 C.F.R. § 1.51(d) are only guidelines that are suggested for applicant's use. They are not mandatory, and when Rule 77 was amended in 1996 (61 FR 42790, Aug. 19, 1996), Bruce A. Lehman, Assistant Secretary of Commerce and Commissioner of Patents and Trademarks, stated in the Official Gazette:

"Section 1.77 is permissive rather than mandatory. ... 1.77 merely expresses the Office's preference for the arrangement of the application elements. The Office may advise an applicant that the application does not comply with the format set forth in 1.77, and suggest this format for the applicant's consideration; however, the Office will not require any application to comply with the format set forth in 1.77."

In view of the above, Applicant prefers not to add section headings.

Regarding the objection to the drawings, Applicant has amended the drawings to include labels. Accordingly, Applicant requests that the objections to the drawings be removed.

Regarding the objections to claims 2-4 and 6-8, Applicant has amended the claims to define "ATE" as automatic test equipment and "RF" as radio frequency; both

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definitions are consistent with the specification (*see, e.g.*, paragraphs 0005 and 0006). Applicant respectfully requests that the objections to the claims be removed.

Applicant has made other minor amendments to the claims to facilitate readability and flow, and these amendments, as discussed below, should also alleviate any concerns/objections as to claims 1-6 and the Beauregard claims (7-8).

Notwithstanding the above, Applicant respectfully traverses the Section 101 rejections of claims 1-8 because the claims are directed to subject matter including method-based and system-based approaches for determining test program parameters that do not rely upon the output or display of such results to a user as suggested in the Office Action, which is consistent with Section 101. For example, relative to claim 1, calculated input and output losses are respectively used to determine real input and output power levels of an amplifier (*e.g.*, to correct a detected output level to correspond to a real output level exhibited by the amplifier, without test equipment losses). The specification supports these limitations, with recited structure such as a computer, memory and test circuits, as is consistent with relevant law (*see, e.g., In re Alappat*, 33 F.3d 1189 (Fed. Cir. 1994) (*in banc*)). While the provision of an output to a user as suggested in the Office Action may be useful, the claimed limitations do not require such limitations and are further applicable to other implementations, such as with an automated test apparatus (*e.g.*, to generate and output test signals without user intervention). In view of the above, the Section 101 rejection of independent claims 1 and 3 should be removed. Regarding independent claim 5, the Section 101 rejection should also be removed for the reasons above, and further because claim 5 is directed to a system to calibrating test program parameters and measuring input and output characteristics of an amplifier, with support in the specification for these tangible aspects (*see, e.g.*, paragraph 29). The Section 101 rejection of independent claims 7 and 8 should also be removed for the reasons stated above, and further because these claims are directed to a machine readable medium for use in testing an amplifier, and specifically for determining and using correction factors for testing the amplifier (*e.g.*, outputting the correction factors for use in testing a circuit). For instance, claim 8 includes limitations directed to setting the power level of ATE for use in testing a circuit, and calculating a corrected output power (*e.g.*, for providing to a user as the results of

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testing the circuit). Accordingly, the Section 101 rejections of claims 1-8 are improper and Applicant requests that they be withdrawn.

As discussed above, Applicant has amended the claims to include language, generally consistent with the claims as filed, for readability as relevant to the use and implementation of test parameters (e.g., as output to a user, or implemented directly in a test apparatus for correcting an test input). Support for these amendments may be found, for example, at paragraphs 14, 15 and 26-29 of the instant application. Applicant submits that the claims, as amended, are proper under Section 101 and requests that the rejections be removed.

Applicant notes that claims 2-4 and 6-8 are not rejected under any prior art and, in view of the above discussion regarding the impropriety of the Section 101 rejections and objections to the claims, believes that these claims are in condition for allowance.

Applicant traverses the Section 103(a) rejections of claims 1 and 5 because the Office Action does not cite to any reference that corresponds to claimed limitations directed to using an input loss correction factor to determine a real input power level and using the output loss correction factor to determine a real output level. The Section 103 rejection relies solely upon the Roberts reference, yet the Office Action acknowledges that the Roberts reference "does not disclose using the input loss correction factor to determine a real input power level; and using the output loss correction factor to determine a real output level." In an attempt to arrive at the claimed limitations, the Office Action appears to allege that Roberts' approach to increasing the gain on an amplifier somehow equates to calculating the real input and output power levels as in the claimed invention. Applicant submits, that while increasing the gain may increase the input and output power levels in certain situations, Roberts' approach in no way discloses calculating the real input and output power levels. In this regard, the Office Action has failed to cite prior art that corresponds to all of the claimed limitations, thus the Section 103(a) rejections of claims 1 and 5 are improper. Accordingly, Applicant requests that the Section 103(a) rejections be withdrawn.

Applicant further traverses the Section 103(a) rejections of claims 1 and 5 because the Office Action cites to a multitude of disparate portions of the Roberts reference without showing how these portions relate to one another or operate together. In many

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instances, the different cited portions relate to different figures and different devices and any relationship is unclear at best. For example, the Office Action cites to Figs. 1 and 4A-B; however, Figs. 4A and 4B illustrate the operation of the system of Fig. 3, not Fig. 1 (see, e.g., col. 9, lines 9-10). As indicated in M.P.E.P. § 2131, "the identical invention must be shown in as complete detail as is contained in the ... claim" (citing *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1239, 9 U.S.P.Q.2d 1913, 1920 (Fed Cir. 1989)). M.P.E.P. § 2131 further indicates that various portions of a reference cannot be asserted together to anticipate a claim unless the reference arranges the limitations as they are arranged in the claim. See, e.g., *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). In failing to cite any portion of the Roberts reference that shows all of the limitations arranged as claimed in the instant application, the Office Action has failed to show correspondence to the claimed limitations in a manner consistent with M.P.E.P. § 2131. While the rejections of claims 1 and 5 are under Section 103(a), the Office Action only cites to the Roberts reference and fails to provide any motivation for combining the various teachings of Roberts. In this regard, the Office Action fails to provide correspondence to all of the claimed limitations, and the Section 103(a) rejections of claims 1 and 5 should be withdrawn.

Applicant further traverses the Section 103(a) rejections because the Office Action failed to cite any evidence of motivation in support of modifying Roberts to "compensate the input loss ... to determine the real input and output power levels for the purpose of adjusting the gain toward the output." Generally, such an argument suggesting that the claimed limitations are inherently present in the Roberts reference must be supported by evidence from the prior art showing that the claimed limitations are necessarily present. Here, the Office Action has not shown or even alleged that the Roberts reference would necessarily include (and disclose) the claimed limitations. Applicant submits that the Section 103(a) rejections should also be withdrawn for these reasons.

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In view of the remarks above, Applicant believes that each of the rejections has been overcome and the application is in condition for allowance. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is asked to contact the agent overseeing the application file, Peter Zawilski, of NXP Corporation at (408) 474-9063.

Please direct all correspondence to:

Corporate Patent Counsel
NXP Intellectual Property & Standards
1109 McKay Drive; Mail Stop SJ41
San Jose, CA 95131

By: 

Name: Robert J. Crawford
Reg. No.: 32,122
(NXPS.201PA)